

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s) : Joachim HASCH et al.

Group Art Unit: 1794

Appln. No. : 10/521,151

Examiner: Thomas, A.

Filed : January 13, 2005

Confirmation No.: 9119

For : BUILDING BOARD

APPEAL BRIEF UNDER 37 C.F.R. §41.37

Commissioner for Patents
United States Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief-Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This appeal is from the Examiner's rejection of claims 1, 2, 4, 7-10, 19, 22, and 23 as set forth in the Final Office Action dated November 23, 2007. A Notice of Appeal and a Request for an Extension of Time under 37 C.F.R. §1.136(a) were timely submitted with appropriate fee payments on March 24, 2008. Accordingly, this Appeal Brief is being timely submitted by the initial due date of May 27, 2008 (i.e., two months from the filing of the Notice of Appeal, May 24, 2008 falling on a Saturday and May 26, 2008 being a holiday). Payment of the requisite fee under 37 C.F.R. §41.20(b)(2) is submitted herewith.

No additional fee is believed to be required for filing the instant Appeal Brief. However, if for any reason the necessary fee is not associated with this file, the undersigned authorizes the charging of any filing fees for the Appeal Brief and/or any necessary extension of time fees to Deposit Account No. 19 - 0089.

(I) REAL PARTY IN INTEREST

The real party in interest is Kronotec AG of Luzern, Switzerland, as assignee of the entire interest in the above-identified application by an assignment recorded in the U.S. Patent and Trademark Office on June 2, 2005, at Reel 016639 and Frame 0460.

(II) RELATED APPEALS AND INTERFERENCES

The Appellants, their legal representatives and the Assignees are not currently aware of any appeals, interferences, or judicial proceedings that may directly affect or be directly affected by or have some bearing on the Board's decision in this appeal. Attached hereto is a Related Proceedings Appendix showing no related appeals or interferences.

(III) STATUS OF THE CLAIMS

In the Final Office Action dated November 23, 2007, claims 1, 2, 4 and 7-23 are pending in the application. Claims 11-18, 20, and 21 are withdrawn. Claims 1, 2, 4, 7-10, 19, 22, and 23 are rejected. Claims 3, 5, and 6 are canceled. No claims are allowed. Accordingly, claims 1, 2, 4, 7-10, 19, 22, and 23 are being appealed and are listed in the "Claims Appendix" attached herewith.

(IV) STATUS OF THE AMENDMENTS

All amendments have been entered. Accordingly, claims 1, 2, 4, 7-10, 19, 22, and 23 as presented in the Amendment Under 37 C.F.R. 1.111 on October 26, 2007, are being appealed, and are listed in the "Claims Appendix" attached herewith.

(V) SUMMARY OF THE CLAIMED SUBJECT MATTER**Independent Claim 1**

By way of non-limiting example, the invention provides for a building board for use as a ceiling or wall element in house building, the building board comprising a plurality of orientated strand boards (OSBs) (see, e.g., reference numerals 1, 2, 3, 1a, 2a, 3a, 1b, 2b, 3b in the Figure) which are disposed side by side and are bonded together in multiple layers (see, e.g., the figure and lines 17-18 of page 3). The building board further comprises some interspaces 4 filled with an insulating material 5 and other interspaces 4 devoid of the insulating material (see, e.g., the figure and line 23 of page 3 through line 1 of page 4). At least one nail plate 7 is disposed between respectively two layers (1a/2a/3a and 1b/2b/3b) and lying one on top of the other (see, e.g., the figure and lines 5-6 of page 4).

(VI) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 2, 4, 7-10, 19, 22, and 23 are rejected under 35 U.S.C. §103(a) for being unpatentable over U.S. Pat. No. 5,098,762 issued to Nakajima (“Nakajima”) in view of U.S. Pat. No. 6,696,167 issued to Sean *et al.* (“Sean”) and either of DE 2606666 (“DE 260666”) or U.S. Pat. No. 6,625,943 issued to Renner (“Renner”).

(VII) ARGUMENTS

Claims 1, 2, 4, 7-10, 19, 22, and 23 are rejected under 35 U.S.C. §103(a) for being unpatentable over U.S. Pat. No. 5,098,762 issued to Nakajima (“Nakajima”) in view of U.S. Pat. No. 6,696,167 issued to Sean et al. (“Sean”) and either of DE 2606666 (“DE 260666”) or U.S. Pat. No. 6,625,943 issued to Renner (“Renner”).

Claims 1, 19, and 22

The rejection of claims 1, 19, and 22 under 35 U.S.C. §103(a) is in error, and the decision of the Examiner to reject these claims should be reversed.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. See MPEP §2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.¹ Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Appellants submit that no proper combination of the applied art teaches or suggests each and every feature of the claimed invention.

¹ While the *KSR* court rejected a rigid application of the teaching, suggestion, or motivation (“TSM”) test in an obviousness inquiry, the [Supreme] Court acknowledged the importance of identifying “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” in an obviousness determination. *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1356-1357 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1731 (2007)).

The present invention relates to a building board for use as a ceiling or wall element. Independent claim 1 recites, in pertinent part, *a plurality of orientated strand boards (OSBs) which are disposed side by side and are bonded together in multiple layers ... and at least one nail plate disposed between respectively two layers lying one on top of the other.* Appellants respectfully submit that no proper combination of the applied art renders the claimed invention obvious.

The Examiner asserts that Nakajima discloses a plurality of boards disposed side by side and bonded together to form multiple layers (Final Office Action, page 3). The Examiner also contends that Sean teaches equivalence between wood and OSB boards, and that it would have been obvious to use OSB boards in Nakajima in view of Sean (Final Office Action, page 3). The Examiner is further of the opinion that DE 2606666 and Renner each disclose the structural equivalence of the use of nail plates and adhesives in bonding boards together (Final Office Action, page 4). The Examiner concludes that it would have been obvious to use nail plates between the layers of Nakajima boards in order to provide a strong joint between the individual layers (Final Office Action, page 4). Appellants respectfully disagree with the conclusion of obviousness, and submit that (i) the applied references fail to disclose or suggest all of the features of the claimed invention; (ii) the rejection is based upon factually unsupported speculation; and (iii) the rejection is based upon impermissible hindsight.

(i) The applied references fail to disclose or suggest and at least one nail plate disposed between respectively two layers lying one on top of the other.

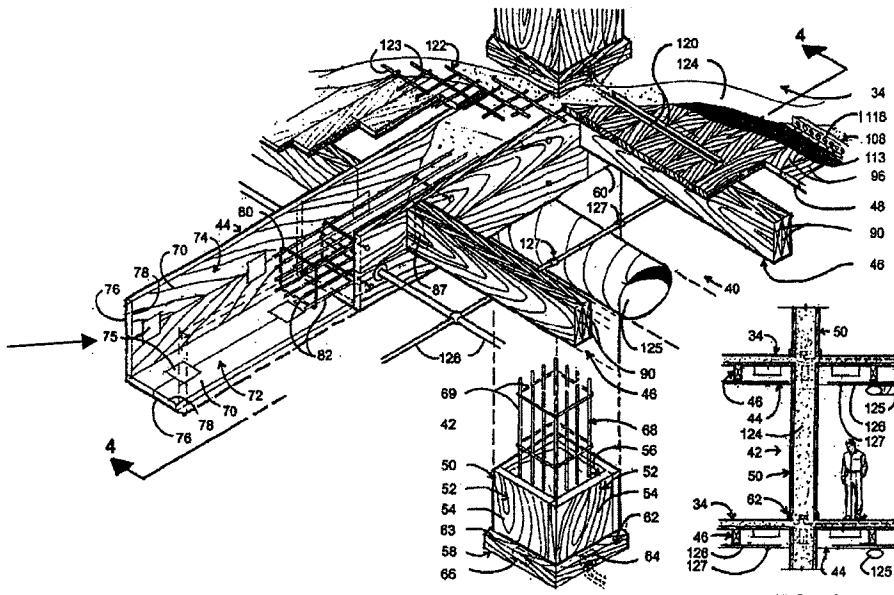
As acknowledged by the Examiner, neither Nakajima nor Sean discloses a nail plate. For example, Nakajima shows multiple boards bonded together to form layers; however, Nakajima only discloses that the layers are adhered together (column 2, line 1). Sean does not disclose a plurality of boards bonded together in layers, and consequently does not disclose any structure

for bonding layers of boards together. Therefore, neither Nakajima nor Sean discloses or suggests at least one nail plate disposed between respectively two layers lying one on top of the other, as recited in claim 1.

DE 2606666 and Renner do not compensate for the deficiencies of Nakajima and Sean with respect to independent claim 1. That is, neither DE 2606666 nor Renner discloses *at least one nail plate disposed between respectively two layers lying one on top of the other*, as recited in claim 1.

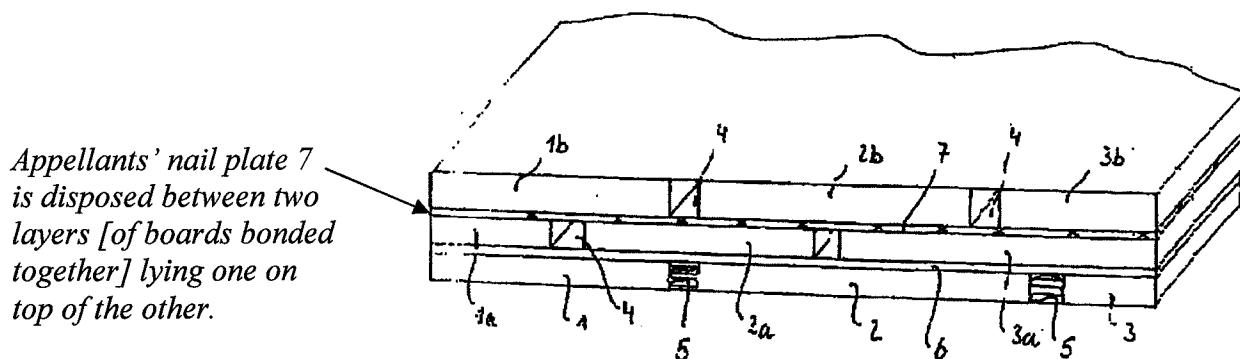
Instead, Renner discloses a building system in which a nail plate 75 spans a gap between two boards arranged end-to-end along longitudinal ends of the boards (e.g., a butt joint). However, the nail plate 75 is not disposed between two layers of boards lying one on top of the other, as shown in FIG. 3 of Renner reproduced below:

The Renner nail plate 75 spans the longitudinal ends of two boards. However, the nail plate 75 is not disposed between two layers of boards lying one on top of the other.

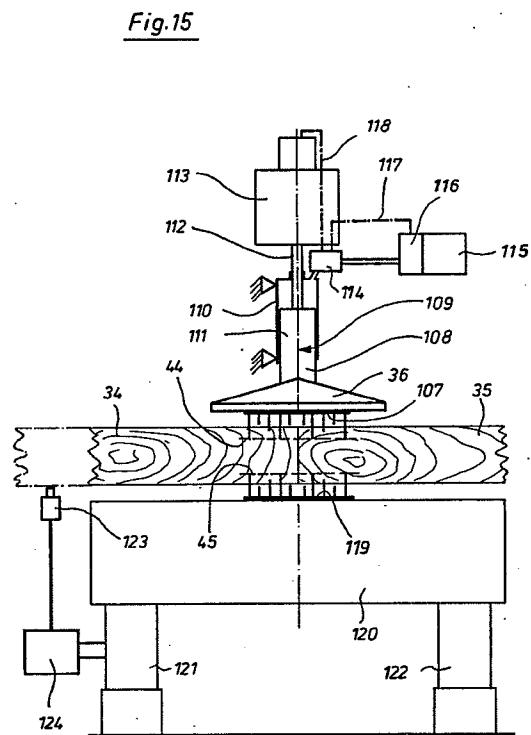


In contrast to Renner's nail plate 75, the nail plate of embodiments of the present invention is disposed between two layers of boards lying one on top of the other. That is, in

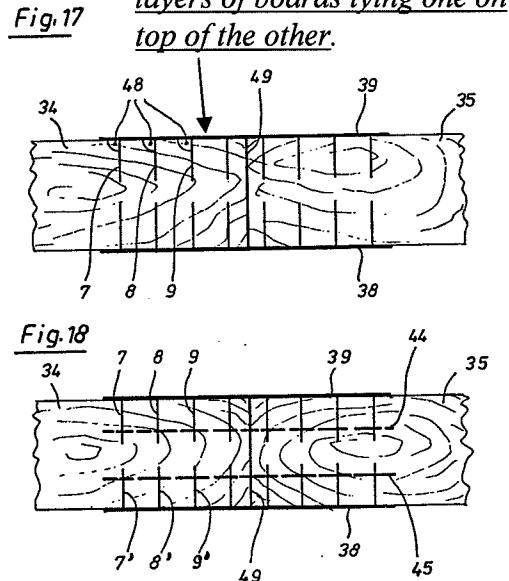
Appellants' invention, the nail plate is sandwiched between two layers, as depicted in the Figure of Appellants' invention, reproduced below:



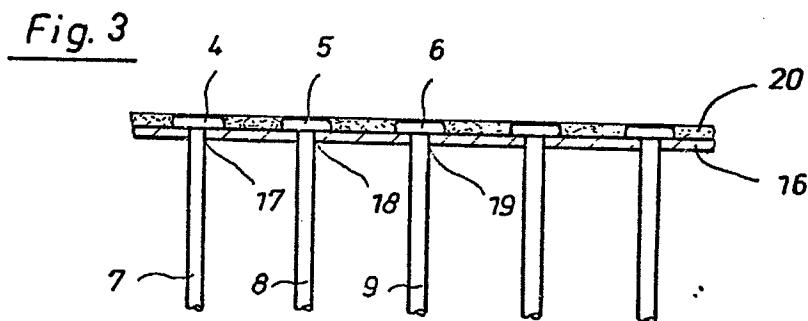
Similar to Renner, DE 2606666 discloses a nail plate used for fixing a butt joint in which two boards are attached end-to-end (see, e.g., FIGS. 15, 17, and 18, reproduced below). Again, this differs from the present invention in which a nail plate is disposed between two layers of boards lying one on top of the other. DE 260666 does not disclose or suggest that a nail plate is arranged between two layers.



The DE 260666 nail plate spans the transverse ends of two boards arranged end-to-end. However, the nail plate is not disposed between two layers of boards lying one on top of the other.



A specific embodiment of the nail plate of DE 2606666 is depicted in FIG. 3 of DE 2606666, reproduced below. Particularly, FIG. 3 shows a metal plate 16 having holes 17, 18, 19 in which nails 7, 8, 9 are held. The heads 4, 5, 6, of the respective nails 7, 8, 9 are held by layer 20, which can be metal or plastic. In this manner, a plurality of nails (7, 8, 9) may be pressed into two boards arranged end-to-end (e.g., in the operation depicted above in FIG. 15), to produce an end-to-end connection of the boards (e.g., as in FIGS. 17 and 18, shown above).



However, the nail plate in FIG. 3 of DE 2606666 is not disposed between two layers of side-by-side boards, as recited in the claimed invention. In fact, Appellants submit that the nail plate of Renner or DE 2606666 would not even operate to affix adjacent layers of Nakajima together, since these prior art nail plates only have nails on a single side. Thus, a skilled artisan would not be motivated to use the nail plate of Renner or DE between adjacent layers of boards Nakajima because such an arrangement would not operate to join the layers of Nakajima.

Thus, both Renner and DE 2606666 disclose a nail plate used for connecting two boards joined end-to-end (Renner along the longitudinal ends, and DE 2606666 along the transverse ends). However, neither discloses or suggests a nail plate disposed between two layers of side-by-side boards lying one on top of the other. Therefore, none of the applied references discloses

or suggests *a plurality of orientated strand boards (OSBs) which are disposed side by side and are bonded together in multiple layers ... and at least one nail plate disposed between respectively two layers lying one on top of the other*, as recited in claim 1.

The Examiner, in the Response to Arguments section of the Final Office Action, asserts that “[e]ven if these references were limited to joining boards end to end, one of ordinary skill in the art would instantly recognize that the nail plates could be used to reinforce any type of butt joint whether it be end to end or otherwise” (Final Office Action, pages 4-5). Without acquiescing in the validity of this assertion, Appellants submit that the Examiner’s remarks do not address the language of the claimed invention. That is, claim 1 does not recite a “butt joint ... end to end or otherwise.” Instead, claim 1 recites, *inter alia*, *a plurality of orientated strand boards (OSBs) which are disposed side by side and are bonded together in multiple layers ... and at least one nail plate disposed between respectively two layers lying one on top of the other*. Therefore, the Examiner’s comments at pages 4-5 of the Final Office Action do not address the actual language of the claimed invention, and fail to cure the deficiency that none of the applied references disclose or suggest a nail plate disposed between two layers of boards lying one on top of the other.

(ii) The rejection is based upon factually unsupported speculation.

In Box 11 of the Advisory Action dated March 10, 2008, the Examiner answers Appellants argument that none of the applied art discloses a nail plate disposed between two layers of boards lying one on top of the other. More specifically, the Examiner states:

...it would have been obvious ... to use nail plates to bond together the boards laying side by side in the products of the primary reference. This will result in some of the nail plates, namely the nail plates on the intermediate layers, being between two layers (i.e., the two outer layers) lying on top of the other.

(Advisory Action, Box 11).

Appellants respectfully disagree with this reasoning, and submit that the Examiner's assertion is mere speculation, factually unsupported by any evidence of record.

Rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Office may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. *See, In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). In this case, there is no teaching of the actual size of the nail plates shown by Renner and DE 2606666. Therefore, it is impossible to state with certainty that, if the nail plate of Renner or DE 2606666 were used to bond Nakajima's boards, any portion of the nail plate would lie between two layers of Nakajima's boards. Yet, this is exactly what the Examiner speculates in the Advisory Action, in an attempt to cure deficiencies in the factual basis of the rejection set forth in the Final Office Action.

In any event, the Examiner's explanation of the rejection set forth in the Advisory Action still does not result in a combination of prior art that contains all of the features of the claimed invention. The Examiner appears to be of the opinion that the nail plate of Renner or DE 2606666 could be used externally to fixate the boards of Nakajima, and that at least a portion of the nail plate would extend between two layers of the Nakajima boards. However, this is not what is recited in the claim. Instead, claim 1 recites *at least one nail plate disposed between respectively two layers lying one on top of the other*. Claim 1 does not recite a portion of a nail plate, or a single nail of a nail plate, being disposed between two layers, as alleged by the Examiner in the Advisory Action. Therefore, even when the Examiner's factually unsupported

speculation is taken at face value for argument sake, it still does not explain a combination that contains all of the features of the claimed invention.

(iii) The rejection is based upon impermissible hindsight.

Appellants also submit that the rejection is based upon impermissible hindsight reasoning. The Court of Appeals for the Federal Circuit has repeatedly cautioned against employing hindsight by using a patent applicant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. *See, e.g., Grain Processing Corp. v. American Maize-Pros. Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). Moreover, it is established law that one "cannot use hindsight reconstruction to pick and chose among isolated disclosures in the prior art to deprecate the claimed invention." *Ecolochem, Inc. v. Southern Calif. Edison Co.*, 227 F.3d 1361 (Fed. Cir. 2000), (citing *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988)).

In this case, none of the applied art teaches or suggests using a nail plate with a layered structure such as that shown by Nakajima. For example, there is no teaching or suggestion in either Renner or DE 2606666 to use a nail plate to bond layers of a layered structured, such as that shown in Nakajima. Instead, both Renner and DE 2606666 teach the use of a nail plate to affix an end-to-end connection of two parallel boards. Moreover, Nakajima does not disclose or suggest using an external fastener, as would be the result of the Examiner's proposed use of a nail plate as explained in the Advisory Action. Instead, Nakajima only teaches that a layer may be adhered to the next layer (paragraph spanning cols. 1 and 2).

Notwithstanding the above-noted lack of teaching in the applied art, the Examiner concludes, nevertheless, that it would have been obvious to the skilled artisan to apply the nail plate of Renner or DE 2606666 to the layered structure of Nakajima. However, because none of the applied references even remotely suggest the arrangement proposed by the Examiner,

Appellants submit that the rejection is necessarily based upon information that the Examiner gleaned only from Appellants' disclosure, which amounts to impermissible hindsight reasoning. Put another way, the Examiner is using Appellants' disclosure as a blueprint for formulating the rejection based upon isolated teachings of the prior art, which renders the rejection unsustainable.

For at least the above-noted reasons, Appellants submit the applied art does not render obvious the combination of features recited in independent claim 1. Moreover, as claims 19 and 22 depend from claim 1, Appellants submit that the applied art fails to obviate these claims as well.

Accordingly, Appellants respectfully request the Board reverse the Examiner's decision to reject claims 1, 19, and 22 and remand the application to the Examining Group for allowance.

Claim 2

The rejection of claim 2 under 35 U.S.C. §103(a) is in error, and the decision of the Examiner to reject this claim should be reversed.

Claim 2 depends from allowable claim 1, and additionally recites the layers of a plurality of boards are additionally connected to one another by mechanical connecting means. For example, as described at lines 5-6 of page 7 of Appellants' specification, in addition to the nail plate, the individual layers can also be nailed, screwed, or clamped together. Appellants submit that the recitation "mechanical connecting means" does not invoke 35 U.S.C. 112, sixth paragraph, because it does not use the phrase "means for" and does not modify the phrase "means for" with functional language.

Appellants note that the explanation of the rejection of claims 1, 2, 4, 7-10, 19, 22, and 23 fails to even address the features of claim 2. Particularly, the Examiner fails to point out how the

applied art discloses or suggests at least one nail plate and the layers of a plurality of boards are additionally connected to one another by mechanical connecting means. This makes the rejection fatally defective on its face, since MPEP §2143.03 states: “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Moreover, 37 C.F.R. §1.104 states: “[t]he examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed ...” (emphasis added). Moreover, MPEP §707.07(d), states that “[a] plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.” In this case, the Examiner has improperly grouped claim 2 with the rejection of other claims while failing to address the language of claim 2.

In any event, Appellants submit that the applied art does not disclose or suggest at least one nail plate and the layers of a plurality of boards are additionally connected to one another by mechanical connecting means. For example, Nakajima only discloses that layers of boards may be adhered to one another, and Sean, Renner, and DE 2606666 do not disclose layers of boards at all. Therefore, the applied art fails to disclose or suggest all of the features recited in claim 2.

Accordingly, Appellants respectfully request the rejection of claim 2 be reversed by the Board, and the application be remanded to the Examining Group for allowance.

Claim 4

The rejection of claim 4 under 35 U.S.C. §103(a) is in error, and the decision of the Examiner to reject this claim should be reversed.

Claim 4 depends from allowable claim 1, and additionally recites at least one plastics mat disposed between two layers lying one on top of the other. The Examiner correctly notes that

Nakajima discloses the use of an interposed material, e.g., a non-woven fabric, between at least two of the layers (see, e.g., lines 1-18 of col. 3, and lines 39-43 of col. 4 of Nakajima). The Examiner impliedly acknowledges that Nakajima does not disclose a plastics mat, but contends that it would have been obvious to use a plastic fabric as the non-woven fabric layer as a matter of design choice (Final Office Action, page 3). Appellants respectfully disagree.

Appellants acknowledge that Nakajima discloses an interposed material that may be a non-woven fabric. However, Nakajima does not disclose or suggest the use of a plastics mat between layers. Nor has the Examiner identified any prior art reference that actually discloses or suggests a plastics mat disposed between layers of boards disposed side by side. Appellants submit that even in proper cases of design choice (Appellants do not concede that this is such a case), there still must be some teaching or suggestion of the claimed features. However, in this case, the Examiner does not apply any reference that teaches or suggests a plastics mat disposed between layers of boards disposed side by side. Nor Examiner does not establish that such a feature is common knowledge in the art. Therefore, the applied references fail to disclose or suggest all of the features of the claimed invention.

Accordingly, Appellants respectfully request the rejection of claim 4 be reversed by the Board, and the application be remanded to the Examining Group for allowance.

Claims 7-10

The rejection of claims 7-10 under 35 U.S.C. §103(a) is in error, and the decision of the Examiner to reject this claim should be reversed.

Claim 7 depends from allowable claim 1, and additionally recites the plurality of OSBs have a length of 2-20 m. Claim 8 depends from allowable claim 1, and additionally recites the plurality of OSBs have a thickness of 50-90 mm. Claim 9 depends from claim 7, and

additionally recites the plurality of OSBs have a length of one of 2-10 m or 4-6 m. Claim 10 depends from claim 7, and additionally recites the plurality of OSBs have a thickness of one of 100-400 mm or 100-250 mm. The Examiner does not identify these features in any applied reference, but rather concludes that it would have been obvious to make the product of the primary reference using boards of any size since a change in size is generally recognized as being within the level of ordinary skill in the art (Final Office Action, page 3). Appellants respectfully disagree, and submit that this rejection is improper because it is conclusory and because the Examiner failed to resolve the level of ordinary skill in the art.

First, Appellants submit that the rejection is unsustainable because the Examiner has not properly resolved the level of ordinary skill in the art, as required by *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), which states:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. *Id at 17.*

As the applied art fails to disclose all of the claimed features (e.g., the dimensions of the OSBs), the underpinning of the rejection rests upon what would have been obvious to one having ordinary skill in the art at the time the invention was made. However, Appellants note that the Examiner fails to adequately resolve the level of ordinary skill in the pertinent art as set forth in MPEP 2141:

Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill. A finding as to the level of ordinary skill may be used as a partial basis for a resolution of the issue of obviousness.

The person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art at the time of the invention. Factors that may be considered in determining the level of ordinary skill in the art may include: (1) "type of problems encountered in the art;" (2) "prior art solutions to those problems;" (3) "rapidity with which innovations are made;" (4)

"sophistication of the technology; and" (5) "educational level of active workers in the field. In a given case, every factor may not be present, and one or more factors may predominate." *In re GPAC*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); *Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc.*, 807 F.2d 955, 962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986); *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983). In the instant rejection, the Examiner fails to adequately resolve the level of ordinary skill in that art. Instead, the Examiner merely alleges that a change in size is generally recognized as being within the level of ordinary skill in the art. However, the Examiner provides no factual support for this allegation. For example, the Examiner does not address any one of the factors (1)-(5) discussed in the above-noted passages of MPEP 2141. Further according to MPEP §2141, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. In the instant rejection the Examiner has not met this initial burden because the Examiner only makes unsupported assertions regarding the level of ordinary skill in the art.

Appellants respectfully submit that, without properly resolving the ordinary level of skill in the pertinent art, one cannot objectively conclude that it would have been obvious to modify Nakajima as asserted by the Examiner. Put another way, without ascertaining the ordinary level of skill in the art, it cannot objectively be said that it would have been obvious to modify the Nakajima boards to have the recited dimensions. For example, there is no evidence in the record that the dimensions recited in Appellants' claims are even within the technical grasp of a person having ordinary skill in the art at the time the invention was made.

Even further, the Examiner has failed to identify any reason that would have prompted a person of ordinary skill in the relevant field to combine elements of the prior art in the way the claimed new invention does. Instead, in the Final Rejection, the Examiner merely concludes that

the it would have been obvious “to make the product of the primary reference using boards of any size” (Final Office Action, page 3). This type of rejection is clearly improper since the Supreme Court has held that rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), quoting *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006).

Accordingly, Appellants respectfully request the rejection of claims 7-10 be reversed by the Board, and the application be remanded to the Examining Group for allowance.

Claim 23

The rejection of claim 23 under 35 U.S.C. §103(a) is in error, and the decision of the Examiner to reject this claim should be reversed.

Claim 23 depends indirectly from allowable claim 1, and additionally recites:

at least one plastic mat structured and arranged to increase the sound-insulation and heat insulation of the building board,

wherein the at least one plastic mat is disposed between the outermost layer and the second layer, and

the at least one nail plate is disposed between the second layer and a third layer of the plurality of orientated strand boards.

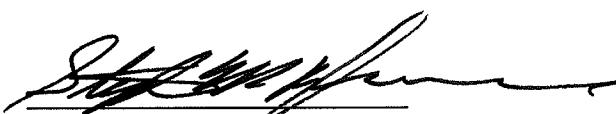
As discussed above with respect to claim 1, none of the applied references teaches or suggests a nail plate between two layers of boards lying one on top of the other. Moreover, as discussed above with respect to claim 4, none of the applied references discloses or suggests a plastics mat disposed between layers of boards. Therefore, Appellants submit that the applied art cannot reasonably be said to suggest the plastic mat and nail plate disposed between specific layers (i.e., the at least one plastic mat between *the outermost layer and the second layer*, and the at least one nail plate between *the second layer and a third layer*), as recited in claim 23.

Accordingly, Appellants respectfully request the rejection of claim 23 be reversed by the Board, and the application be remanded to the Examining Group for allowance.

Conclusion

In view of the foregoing remarks, Appellants submit that claims 1, 2, 4, 7-10, 19, 22, and 23 are patentably distinct from the prior art of record and are in condition for allowance. Accordingly, Appellants respectfully request that the Board reverse the Examiner's rejection of claims 1, 2, 4, 7-10, 19, 22, and 23, and remand the application to the Examiner for allowance of the pending claims.

Respectfully submitted,
Joachim HASCH et al.



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(VIII) CLAIMS APPENDIX

The following is a listing of the claims involved in the appeal.

1. A building board for use as a ceiling or wall element in house building, comprising a plurality of orientated strand boards (OSBs) which are disposed side by side and are bonded together in multiple layers, further comprising some interspaces filled with an insulating material and other interspaces devoid of the insulating material, and at least one nail plate disposed between respectively two layers lying one on top of the other.
2. The building board as claimed in claim 1, wherein the layers of a plurality of boards are additionally connected to one another by mechanical connecting means.
4. The building board as claimed in claim 1, further comprising at least one plastics mat disposed between two layers lying one on top of the other.
7. The building board as claimed in claim 1 wherein the plurality of OSBs have a length of 2-20 m.
8. The building board as claimed in claim 1 wherein the plurality of OSBs have a thickness of 50-90 mm.
9. The building board as claimed in claim 7, wherein the plurality of OSBs have a length of one of 2-10 m or 4-6 m.

10. The building board as claimed in claim 7, wherein the plurality of OSBs have a thickness of one of 100-400 mm or 100-250 mm.

19. The building board of claim 1, wherein:

the some interspaces filled with an insulating material are provided in a first layer of the plurality of boards, and

the other interspaces devoid of the insulating material are provided in a second layer of the plurality of boards.

22. The building board as claimed in claim 1, wherein:

the interspaces filled with insulating material are disposed in an outermost layer of the plurality of orientated strand boards, and

the interspaces devoid of insulating material are disposed in a second layer adjacent the outermost layer.

23. The building board as claimed in claim 22, further comprising at least one plastic mat structured and arranged to increase the sound-insulation and heat insulation of the building board,

wherein the at least one plastic mat is disposed between the outermost layer and the second layer, and

the at least one nail plate is disposed between the second layer and a third layer of the plurality of orientated strand boards.

(IX) EVIDENCE APPENDIX

NONE.

(X) RELATED PROCEEDINGS APPENDIX

NONE.